

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 10/086,826
Attorney Docket No.: Q67676

REMARKS

Claims 1, 3-9, 11-14, 16-22, 24-27, 29-35, 37-40 and 42-51 are all the claims pending in the application. Claims 2, 10, 15, 23, 28, 36 and 41 have been canceled. Claims 49-56 have been added. No new matter has been added.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 2, 4, 5, 7, 11, 14, 15, 17, 18, 20, 24, 27, 28, 30, 31, 33, 37, 40, 41, 43, 44 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art (hereinafter APA) in view of U.S. Patent No. 6,345,180 (Reichelt). Claims 3, 8, 16, 21, 29, 34 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Reichelt and further in view of U.S. Patent No. 6,311,069 (Havinis et al.). Claims 6, 19, 32 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Reichelt and further in view of U.S. Patent No. 6,516,190 (Linkola). Claims 9, 22 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Reichelt and further in view of U.S. Patent No. 6,347,278 (Ito). Claims 10, 23 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Reichelt and further in view of U.S. Patent No. 6,259,921 (Totaro et al.). Claims 12, 13, 25, 26, 38, 39, 47 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Reichelt and further in view of U.S. Patent No. 6,453,168 (McCrary et al.).

These rejections are respectfully traversed. Claims 1, 3-9, 11-14, 16-22, 24-27, 29-35, 37-40 and 42-56, being all the claims presently in this application, are patentably distinguishable over the cited prior art for the following reasons.

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Applicant has amended independent claims 1, 14, 27 and 40 so that they now set forth a radio apparatus which sends a message including the position that is the location of the closest base station. The subject matter added to the independent claims is similar to subject matter previously included in claims 10, 23 and 36. Therefore, Applicant will first address the combination that the Examiner used in rejecting claims 10, 23 and 36.

The Examiner rejected claims 10, 23 and 36 under 35 U.S.C. § 103(a) as being allegedly unpatentable over the admitted prior art (hereinafter APA) in view of U.S. Patent No. (6,345,180) Reichelt and further in view of U.S. Patent No. 6,259,921 (Totaro et al.). Applicant submits that claims 1, 14, 27 and 40, which include the subject matter of claims 10, 23 and 36, are allowable over the cited references, at least because even in combination the references do not teach or suggest each and every claimed element.

Claim 1 sets forth an apparatus which sends a message which includes the position the nearest base station, so as to give some information even if the apparatus cannot determine the position where the apparatus itself is located. The Examiner asserts that the combination of the APA, Reichelt and Totaro teaches the claimed invention. However, the only suggestion that it would be useful to send a message including the position of the closest base station in response to judging whether a radio apparatus is able to determine its position is in the subject application.

First, Reichelt is directed at conserving battery power. One method Reichelt teaches to conserve power is that it is desirable to withhold location updates when its power is low. The Examiner assert that this low power state is set when Reichelt cannot determine its position. However, Reichelt only teaches that it is undesirable to send location update information, not

Reichelt cannot determine its position. In fact, Reichelt only stops updates if the system allows it to stop the updates, and continues the updates if the system requires it. (*See* Steps 426-428 and column 8, lines 41-44) Therefore, Reichelt does not teach any action in response to judging whether the device can determine its position. Further, claim 1 sets forth sending a message if the radio apparatus judges that it cannot determine its position. Even if Reichelt's low power state was set in response to not being able to determine its position, Reichelt attempts to limit sending location update information in a low power state, not to send a message in the low power state. Therefore, Reichelt is not relevant to claim 1.

The Totaro fails to make up the above noted deficiencies of Reichelt and would not be combined with Reichelt and the APA to make the invention of claim 1. Totaro is directed at decreasing the routing distance between two terminals and thus tries to force different terminals to be in the same base station region. In order to accomplish this, Totaro teaches a terminal which is "forced" to register in the coverage area of base station to which is closest to a second terminal. (*See* Totaro column 5, lines 34-40) The terminal 5 is registered in a base station area that it is not closest to, so it does not send a message including the location of the closest base station. Further, terminal 4 sends out the initial call and forces terminal 5 to register in the base station area of terminal 4. (*See* column 5, lines 10-11) The claimed invention teaches a radio apparatus which sends a message containing the location of the closest base station to a sender of a radio signal. It is unclear what in Totaro the Examiner considers the radio apparatus which receives a radio signal and sends a message including information about the location of the closest base station. However, even if it were accepted that Totaro teaches sending the location

of the closest base station, Totaro would teach doing so when two terminals were at a distance, in order to decrease the routing distance between the distant terminals. Totaro alone does not teach sending the position of a base station based on judging whether the position of a radio apparatus can be determined. The Examiner asserts that Reichelt teaches limiting updating information when it cannot determine its position information. Therefore, even if the Examiner's assertions concerning Reichelt were accepted, the combination of Reichelt and Totaro also would teach withholding or limiting the messages when a terminal cannot determine its position. Even in combination, the cited references do not teach all of the elements of claim 1. In view of the above arguments, claim 1 is allowable over the combined teaching and suggestion of the APA, Reichelt and Totaro.

The Examiner has cited numerous other references in rejecting other claims of the application. However, the Examiner does not cite any of them for the feature of sending a message which includes the position of the closest base station or that sending such a message is dependent on a judging means. Therefore, even all of the cited references considered together do not teach each and every feature of claim 1 and the claim 1 of the subject application is allowable even over the combined teachings of all of the cited references.

Claims 14, 27 and 40 are allowable at least for reasons similar to those discussed above with respect to claim 1.

Claims 3-9, 11-13, 16-22, 24-26, 29-35, 37-39 and 42-49 depend from one of claims 1, 14, 27 and 40 and are therefore allowable at least because of their dependency.

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Claims 2, 10, 15, 23, 28 and 36 have been canceled, rendering the rejection of those claims moot.

New Claims


New claims 49-56 have been added to more fully define the invention. New claims 49-56 depend from one of claims 1, 14, 27 and 40 and are therefore allowable at least because of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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